

## **REMARKS**

### **I. Overview**

The invention claimed by the Applicants includes numerous elements not disclosed in art cited by the Examiner. To reject applicant's claims, the Office Action must cite prior art that discloses each and every claim element. There are several distinctions between the invention described in Applicants' claims and the apparatus disclosed in U.S. Patent 1,866,531 to Harding ("Harding").

The Applicants' claims include but are not limited to covering a shaker apparatus suitable for use by consumers to shake mixtures such as nail polish with causing the components of the nail polish to separate. Applicants' apparatus is designed to be portable, suitable for inclusion in a small travel bag, and to operate in a quiet manner that is consistent with consumer requirements. These attributes manifest themselves in claim elements that are not taught by Harding.

- **Tilting/Flex Motion.** Even if Harding discloses motion equivalent to the lateral and eccentric motion of Claim 39 and other claims (a conclusion that the Applicants disagree with), Harding does not disclose any tilting, flexing, or other motion outside the plane of the rotational motion. Such tilting is not inherent, and would actually be contrary to the purpose, structure, and sustainability of the Harding apparatus. Harding teaches rotation within a single plane. Any tilting would be contrary to the "sifting" function of Harding, because efficient "sifting" requires that the apparatus not cause sand to congregate at one end or another by a tilting motion. In contrast, Applicants' claims are designed to cover motion that is not limited to a single plane.
- **Portability.** Applicants' apparatus is portable. As provided in claims 15 and 20, the apparatus can have a mass no greater than 6.8 kilograms. Harding does not teach any mass-based limitations, so Harding cannot be said to anticipate claims 15 and 20.
- **Quiet Operation.** As provided in claim 16, Applicants' apparatus is remarkably quiet without the use of any extraneous sound dampening mechanisms. Harding does not teach any sound-based limitations.

In summary, Harding does not anticipate all of Applicants' claim elements.

## **II. CLAIM INTERPRETATION ISSUES**

Many claims have been modified to address the concerns raised in the Office Action. For example, Claim 1 has been modified to positively claim the “shaft” and “bearing” elements. Similarly, the contents-oriented limitations of claims 14 and 18 have been removed. Claims 21-22 have been modified to positively claim a “power source.” The “generally vertical axis” element has been removed from claim 23 and its dependents. The weight limitation of claim 20 has been translated into a mass limitation.

## **III. SECTION 112 REJECTIONS**

Claims 1-38: As discussed above, “shaft” and “bearing” elements are positively claimed.

Claims 3-4: Claim 1 already provides that flex occurs according to the translation of the container base. Nonetheless, claims 3-4 have been modified to provide additional detail.

Claims 5-6: The elements in claims 5-6 do not constitute a “narrative.” Such a conclusion would result in any motion-based or non-static based claim elements as mere narrative. Nonetheless, the tilting of the container has been added to claim 5 and certain spatial relationship limitations have been added to claim 6.

Claims 8, 26-29: As originally filed, these dependent claims include motion and spatial relationship limitations that pertain to the components of the apparatus. The claimed limitations address what the components are doing in relationship to each other. Using the logic of the rejection, adding a “rotation” limitation to an apparatus claim to limit a particular type of motion would be mere “narrative.”

Claims 10 and 24: The specification provides the details as to how the functionality of claims 10 and 24 are accomplished. Claims 10 and 24 have been amended to remove the “configured” language.

Claim 12: Motion of the container base is not mere “narrative.” Motion of a structural element is a material claim element. As discussed above, to conclude otherwise would mean that all apparatus claims would be limited to static structures and could not include operational devices that involve motion and function. Claim 12 has been amended to address the motion of the container.

Claim 13: Claim 13 as amended limits to the scope of the claim by limiting the scope and magnitude of motion covered by claimed apparatus.

Claim 16: The noise level referred to in the claim pertains to the aggregate noise generated by the totality of the moving parts in the apparatus. The rotation and tilting motions of the various components result in the claimed limitation.

Claim 17: This claim has been amended to specifically link types of materials to claim elements.

Claim 30, 33-38: Claim 30 has been amended to invoke 35 USC 112 6<sup>th</sup> paragraph.

#### **IV. SECTION 102 REJECTIONS**

Among other distinctions, the “tilting/flexing” motion is found in all Applicants’ claims and is not disclosed by Harding. Paragraph [0002] of Background of highlights the problems associated with repeating the same motion over and over again on a mixture of multiple substances. As discussed, prior art devices act as a “centrifuge” and result in “separation of substances with different densities” such as nail polish.

In contrast to Applicants’ Figure 6 and numerous references in Applicants’ specification, no drawing or text in Harding discloses any tilting motion. The purpose of Harding is for the “riddling or sifting sand” (e.g. to separate sand from other solid objects in the sand). The purpose of sifting is to separate, while the purpose of Applicants’ tilting motion is to prevent separation. The motion involved is distinct, and accordingly, Applicants’ claims are distinct. Thus, none of Applicants’ claims can be properly rejected pursuant to 35 USC 102.

As discussed above, the mass-based and noise-based limitations are not disclosed in Harding. The claims as originally filed and as amended include additional distinctions.

### **CONCLUSION**

Applicants believe that all claims as amended are in condition for allowance. If the Examiner disagrees with that conclusion, Applicants hereby request a telephone interview with the Examiner to discuss any outstanding issues. Before conducting such an interview, the Applicants would propose sending a video of the apparatus and its motion-based attributes to the Examiner in preparation for the interview.

A one-month extension fee of \$60 is paid with the submission of this paper.

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Respectfully submitted,

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